

REMARKS

By this amendment claims 1-5 have been amended. Claims 1-5 are pending in the application. Applicant reserves the right to pursue the original claims and other claims in this and other applications.

Claims 1 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mochizuki (US 6,097,814) in view of Tognazzini (US 6,600,713), and further in view of Miller et al. (US 6,535,911). This rejection is respectfully traversed. In order to establish a *prima facie* case of obviousness “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. §2142. Mochizuki, Tognazzini, nor Miller et al., even when considered in combination, do not teach or suggest all limitations of independent claim 1.

Claim 1, as amended, recites an optical recording medium which stores, *inter alia*, “a version checking program for: causing a version information of updated software to be transmitted to a computer, and causing the computer to compare the version information of the updated software to the software to be distributed” (emphasis added). Applicant respectfully submits that none of Mochizuki, Tognazzini, or Miller et al. discloses, teaches, or suggests these limitations.

Miller et al. teaches that “server computer 105 can determine whether viewing computer 155 has the latest version of each required file.” Col. 6, ln. 41-43. Applicant respectfully submits that Tognazzini does not disclose, teach, or suggest a version checking program for causing a version information of updated software to be transmitted to a computer, and causing the computer to compare the version information of the updated software to the software to be distributed, as recited in claim 1. Nor do Mochizuki or Tognazzini disclose, teach, or suggest these limitations. Thus, Mochizuki and Tognazzini do not remedy the deficiencies of Miller et al.

Moreover, M.P.E.P. §2143 delineates the three criteria for establishing a *prima facie* case of obviousness as: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Office Action has failed to make a *prima facie* case of obviousness under this M.P.E.P. provision. None of the cited references contain a suggestion or a motivation for their combination. None of the references sets forth a reasonable expectation of success in their combination. The Office Action does not identify where a suggestion to combine the references exists or why a reasonable expectation of success of combining the references exists. Rather, information contained in the current application is impermissibly used, in hindsight, to pick and choose features of the references to combine to arrive at the present invention. The Office Action makes general allegations that one skilled in the art would be motivated to combine the references without specifically pointing to any teaching in any reference to suggest such a motivation.

Since Mochizuki, Tognazzini, and Miller et al. do not teach or suggest all of the limitations of claim 1, nor is there a motivation to combine the references, claim 1 and dependent claim 4 are not obvious over the cited references. Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claims 1 and 4 be withdrawn.

Claims 2-3 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mochizuki in view of Shaw (US 6,381,741), in view of Tognazzini, and still further in view of Miller et al. This rejection is respectfully traversed.

Claim 2, as amended, recites an optical recording medium which stores, *inter alia*, “a software updating program for: causing a version information of updated software to be transmitted to a computer, [and] causing the computer to compare the version information of the updated software to the software to be distributed” (emphasis added). Claims 3 and 5 recite similar limitations for an optical recording medium, and a method of updating software, respectively. Applicant respectfully submits that none of Mochizuki, Shaw, Tognazzini, nor Miller et al. teaches or suggests these limitations.

To the contrary, Miller et al. teaches that “server computer 105 can determine whether viewing computer 155 has the latest version of each required file.” Col. 6, ln. 41-43. Applicant respectfully submits that Tognazzini does not disclose, teach, or suggest a software updating program for causing a version information of updated software to be transmitted to a computer, and causing the computer to compare the version information of the updated software to the software to be distributed, as recited in claim 2. Nor do Mochizuki, Tognazzini, or Shaw disclose, teach, or suggest these limitations. Thus, Mochizuki, Tognazzini, and Shaw do not remedy the deficiencies of Miller et al.

In addition, the “requisite prior art suggestion to combine becomes less plausible when the necessary elements can only be found in a large number of references. . . .” *Eli Lilly & Co. v. Teva Pharms. USA, Inc.*, 2004 U.S. Dist. LEXIS 14724 at *104; 2 *Chisum on Patents* § 5.04[1][e][vi]. In the present application, the lack of identifiable objective motivation to combine the four references, in addition to the sheer number of disparate references applied by the Office Action, is sufficient to overcome the asserted obviousness arguments.

Since Mochizuki, Shaw, Tognazzini, and Miller et al. do not teach or suggest all of the limitations of claim 2, nor is there a motivation to combine the references, claim 2 is not obvious over the cited references. Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claims 2-3 and 5 be withdrawn.

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Dated: December 21, 2006

Respectfully submitted,

By 

Mark J. Thronson

Registration No.: 33,082

Rachael Lea Leventhal

Registration No.: 54,266

DICKSTEIN SHAPIRO LLP

1825 Eye Street NW

Washington, DC 20006-5403

(202) 420-2200

Attorneys for Applicant